

Notice of Allowability

Application No.

10/757,321

Examiner

Chukwuma O. Nwaonicha

Applicant(s)

MIYAZAWA ET AL.

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 1-6, 12 and 41-46 (now renumbered 1-13, respectively).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance

☐ Other _____


JONANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1600

DETAILED ACTION

Current Status

- 1 This action is responsive to Applicants' amendment of 7 March 2006.
- 2 Receipt and entry of Applicants' amendment is acknowledged.
- 3 Claims 1-6,12 and 41-46 are pending in the application.

CORRECTION OF INVENTORSHIP

In view of the papers filed 9/28/05, the inventorship in this nonprovisional application has been changed by the deletion of Mitsuru Takase, Yoshiyuki Iiyoshi and Noriaki Kawahara.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Election/Restrictions

Applicant's election without traverse of Group I (Claims 1-6,12 and 41-46) in the reply filed on 9/28/05 is acknowledged. Applicants are reminded of their right to file divisional applications to the non-elected claims.

Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Applicants' claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

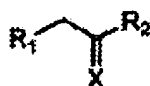
Allowed Claims

Claims 1-6, 12 and 41-46 are allowable over the prior art of record.

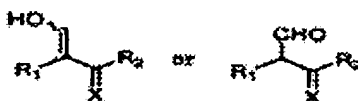
Reason For Allowance

The following is an examiner's statement of reasons for allowance:

Applicants claim a process to produce compounds represented by a formula II comprising the reaction of compound of formula I with formic acid ester or an orthoformic acid ester in the presence of a Lewis acid and a base; wherein all the other variables are as defined in the claim.



formula I



formula II

The process was neither found to be obvious nor anticipated by the prior art of record.

The closest prior art is Kanemasa et al., {Lewis acid-catalyzed reactions of ethyl diazoacetate with aldehydes. Synthesis of α -formyl esters by a sequence of aldol reaction and 1,2-nucleophilic rearrangement, Tetrahedron Letters, 40, 1999, 5055-5058}. Mahmood et al. teach a process for producing applicants claimed compounds; comprising the reaction of as ester and aldehyde in the presence of a Lewis acid. See

page 3334, schemes 1 and 2. The difference is not readily apparent and would not have been suggested to one of ordinary skill.

All claims (1-6,12 and 41-46) are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Chukwuma O. Nwaonicha, Ph.D.
Patent Examiner
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Supervisory Patent Examiner,
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